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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,795

08/10/2005

Federico Mancosu

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07/28/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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EXAMINER

JENKINS, JERMAINE L

ART UNIT

PAPER NUMBER

2855

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/518,795	MANCOSU ET AL.	
	Examiner	Art Unit	
	Jermaine Jenkins	2855	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12212004,08102005</u> .   | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 12-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20, 21 & 24-33 of copending Application No. 10/518,715. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/518,715 teaches all the basic features of the claimed invention; therefore, the application is deemed non-distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12, 18, 22, 24, 26, 28, 30 & 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Karbo et al (4,160,234).

In regards to claims 12, 30 & 31, Karbo et al teaches a system for sensing a parameter of a tire fitted to a vehicle comprising a movable unit (30, i.e. transmitting assembly: The movable unit (30) is attached to a tire (10) that rotates during movement thus causing the unit (30) to move.), a fixed unit (16, i.e. receiver), wherein the movable unit (30) is combined with the tire (10) (Column 3, lines 23-25, See Figure 1), wherein the movable unit (30) comprises a device (30) for sensing the at least one characteristic parameter (i.e. pressure), a device (28, i.e. antenna) for transmitting a signal out of the tire (10), a device (50, i.e. transducer) for generating electrical energy (Column 4, lines 3-8 & 33-39, Column 5, lines 1-3 & Column 6, lines 62-68), wherein the signal relates to the at least one characteristic parameter (Column 4, lines 40-46), wherein the fixed unit (16) is combined with the vehicle (See Figure 1), wherein the fixed unit (16) comprised a device (18, i.e. antenna) for receiving signals from the movable unit (30) (Column 3, lines 55-60), wherein the electrical energy generating device (50) is capable of supplying electrical energy to the sensing device (30), wherein the electrical energy generating device (50) is capable of supplying electrical energy to the transmitting

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device (58) (Column 5, lines 1-12; See Figure 4), wherein the electrical energy generating device (50) comprises a capacitor (74) that charges itself with electrical energy in response to mechanical stress applied to the tire (10) (Abstract; Column 4, lines 17-52).

With respect to claims 18, 22, 24, 26 & 28, Karbo et al teaches wherein the sensing device, the transmitting device, and the generating device are produced on a substrate (34, i.e. mounting member) (Column 4, lines 16-19; See Figure 3).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19, 21, 23, 25, 27 & 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karbo et al (4,160,234) in view of Widner (6,199,575).

With respect to claims 19, 21, 23, 25, 27 & 29, Karbo et al teaches the claimed invention except for the movable unit being produced by micro-electro-mechanical systems (MEMS) technology. Widner teaches a pressure sensing apparatus having a movable unit being produced by micro-electro-mechanical (MEMS) technology (Column 2, lines 10-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use MEMS technology as taught by Widner into the tire

monitoring system of Karbo et al for the purpose of functioning as a mechanical actuator for the structure (Column 2, lines 10-15).

***Allowable Subject Matter***

7. Claims 13-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermaine Jenkins whose telephone number is 571-272-2179. The examiner can normally be reached on Monday-Friday 9am-530pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Lefkowitz can be reached on 571-272-2180. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A.U. 2855



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